

REMARKS

Reconsideration and allowance of the subject application are respectfully solicited.

Initially, Applicant notes that U.S. Patent No. 6,970,639 (McGrath et al.) is cited in a rejection in the Office Action, as discussed below. The PTO-892 (“Notice of References Cited”) attached to the Office Action, however, does not cite McGrath et al., but instead cites a similar patent number, specifically U.S. Patent No. 6,870,639 (Oshita). Applicant kindly requests that a new PTO-892 citing McGrath et al. be provided with the next Office communication.

Claims 1 through 18 remain pending, with claims 1, 13, and 15 through 18 being independent. Claims 1, 2, 4 through 9, and 12 through 18 have been amended. Support for the amendments can be found throughout the originally-filed disclosure, including, for example, in Figure 5, and at page 17, lines 4 through 9 of the specification. Accordingly, Applicant submits the amendments include no new matter.

Claims 1-18 are objected to in the Office Action because of informalities. Specifically, the Office Action asserts that it should be indicated in the claims that the acronym “EDL” stands for “Edit Decision List.” In response, Applicant has amended each of independent claims 1, 13, and 15 through 18 to recite “Edit Decision List (EDL)” in the first reference to this feature. Accordingly, Applicant submits the objection to the claims has been overcome.

Claim 5 is rejected in the Office Action under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action asserts that the features recited in this claim are not supported in the specification.

Applicant respectfully traverses this rejection. Originally-filed claims of an application, when written in ordinary, non-generalized language, constitute their own written

description. MPEP § 2163. In this case, originally-filed claim 5 provides its own written description.

Applicant also submits that a written description of the features of claim 5, both as originally-filed and as amended herein, can be found in the originally-filed specification. For example, page 17, lines 4 through 9 of the specification discloses that track control attributes in a decoupled arrangement may refer to an EDL element follow a list of other EDL elements. Such a description provides support for commencement of the dependent media track is dependent upon a track control attribute associated with an EDL element which is positioned in the sequence of EDL elements prior to a first EDL element in the ordered sub-set of the EDL elements, as recited in amended claim 5.

Claim 7 is also rejected in the Office Action under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Applicant respectfully traverses this rejection. As noted above, originally-filed claims of an application, written in ordinary, non-generalized language, constitute their own written description. In this case, originally-filed claim 7 provides its own written description.

Applicant also submits that a written description of the features of claim 7, both as originally-filed and as amended herein, can be found in the originally-filed specification. For example, the “Suppress” and “Apply” attributes described in Table 1 at pages 14 and 15 of the specification disclose that generation using the referenced media continues until another media item with an Apply attribute set to TRUE is encountered, but will be suppressed for media items with the Suppress attribute set to TRUE. Thus, this description provides support for an EDL element having the parameter Apply set to TRUE to terminate a dependent media track, with the

EDL element being located in a sequence of EDL elements after a final EDL element in a sub-set of EDL elements, and, accordingly, provides support for the features recited in claim 7.

Claims 15 and 16 are rejected in the Office Action under 35 U.S.C. § 101, as being directed to non-statutory subject matter. Specifically, the Office Action asserts that these claims recite computer program modules comprising computer program code, but do not recite a computer-readable medium or memory, and, thus, are non-statutory.

Applicant respectfully traverses these rejection. Nevertheless, claims 15 and 16 have been amended herein to now recite, inter alia, a “computer program product including a computer readable storage medium having recorded thereon a set of computer program modules[.]” Applicant submits, therefore, that amended claims 15 and 16 recite statutory subject matter.

Claim 17 is rejected in the Office Action is rejected as being directed to non-statutory subject matter. Specifically, the Office Action asserts that the recited computer readable medium could be a “signal,” and, therefore, encompasses non-statutory subject matter.

In response, Applicant has amended claim 17 to now recite a computer readable “memory.” Applicant submits, therefore, that amended claim 17 does not encompass non-statutory subject matter.

Claims 1-7 and 12-18 are rejected in the Office Action under 35 U.S.C. § 102(e) as being anticipated by McGrath et al. Claims 8 through 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over McGrath et al. in view of U.S. Patent No. 5,801,685 (Miller et al.).

Applicant respectfully traverses the rejections, and submits the claims are patentably distinguishable from the cited references for at least the following reasons.

The Office Action cites McGrath et al. as disclosing, *inter alia*, a sequence of EDL elements in the form of portions of a source content, with the EDL elements corresponding to a sequence of media items in the form of the source content.

Applicant respectfully submits, however, that the Office Action's equating of the source content to both the EDL elements and a sequence of media items of the claimed invention is improper. As recited in amended independent claims 1, 13, and 15 through 18, the EDL elements and source content are two distinct features. Moreover, the independent claims recite functional relationships between the EDL elements and the source media track, as well as the dependent media track. As such, the source content alone of McGrath et al. cannot be taken to anticipate all of the distinctly claimed features and relationships.

Applicant further submits that McGrath et al. does not disclose or suggest an ordered subset of a sequence of EDL elements containing track control attributes for corresponding dependent media items in a dependent media track, wherein at least one media item in the dependent track is dependent upon a track control attribute in an EDL element in the neighborhood of a corresponding EDL elements in the sub-set, as recited in amended independent claims 1, 13, and 15 through 18. As noted above, the Office Action asserts McGrath et al. discloses a sequence of EDL elements in the form of portions of a source content, with the EDL elements corresponding to a sequence of media items in the form of the source content. The Office Action further equates the template metadata of McGrath et al. to track control attributes, and a subset of portions of the source content to a sub-set of EDL elements. Assuming, *arguendo*, that McGrath et al. can be properly interpreted to disclose such features, the reference cannot then be taken to further disclose source content related to portion of template metadata, with the related portion of the template metadata "in the neighborhood" of a template

section corresponding to the source content, as would necessarily have to follow in order to equate the features of the references to the features of the amended claims. Applicant also notes in this regard that McGrath et al. discloses a one-to-one relationship between the template metadata and the source metadata. See, e.g., col. 2, line 9 through 13, and col. 7, lines 49 through 52.

Applicant further submits the secondary citation to Miller et al. does not cure the deficiencies McGrath et al. The Miller et al. reference is cited as suggesting certain features of the dependent claims. Assuming, arguendo, that Miller et al. does suggest the features as asserted in the Office Action, Applicant submits that the reference does not suggest the features of claims not taught or suggested by McGrath et al., as described above.

For at least the foregoing reasons, Applicant submits that McGrath et al. and Miller et al., whether taken individually or collectively, fail to suggest the claimed invention.

Applicant submits that this application is in condition for allowance, and a Notice of Allowance is respectfully requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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